

REMARKS

Claims 1-2 and 4-9 are pending in the application. Claim 8 is hereby amended to further describe inventive aspects of the current invention, and not to overcome any rejection of the Examiner or any known prior art.

Claims 1-2, 4 and 7 stand rejected by the Examiner under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,226,365 B1 (“Mashinsky”). While the grounds for the rejection of Claims 8 and 9 is not clear from the current October 7, 2004 Office Action, it is presumed from the Examiner’s earlier comments that Claims 8 and 9 are rejected on the same grounds.

Claim 1 recites, in part, “preventing a requester from accepting the response after the session is terminated.” Antecedent basis for “the response” is provided by Claim 1 as “at least one response reflecting at least one telecommunication service offering capable of satisfying the requested telecommunication service...” Nowhere in Mashinsky does it disclose, teach, or suggest preventing a requester from accepting such a response after a session is terminated. The Examiner asserts that Mashinsky discloses such a limitation at Column 13, lines 29-31. However, such reference discloses only that a transaction is canceled after a requesting carrier denies a response communicated to the carrier that the service could not find connection minutes at the price the carrier requested. Stating that a transaction is canceled is not the same thing as teaching that a requester is prevented from accepting a response later. At best, the Examiner seems to be asserting an obviousness-type rejection of such an element more properly asserted under 35 U.S.C. 103.

However, even under 35 U.S.C. 103, Mashinsky does not suggest what the Examiner is asserting. Citing a statement that a transaction can be canceled does not disclose, teach, or

suggest the unique combination of elements recited by Claim 1. For example, unlike Claim 1, the cited portion of Mashinsky (Column 13, lines 29-31) is concerned with a response that *does not* meet a requester's request. Thus, such a rejection ignores the express limitation of Claim 1 that the response is "reflecting at least one telecommunication service offering *capable of satisfying the requested telecommunication service*" (emphasis added). The portion of Mashinsky concerned with a response that *satisfies* a carrier's request is steps 512a-e of Figure 5, described in the lower portion of Column 12. Nowhere with regard to such a request does Mashinsky disclose "preventing a requester from accepting [such a] response after the session is terminated." As Mashinsky clearly does not disclose, teach, or suggest the combination of elements recited by Claim 1, Applicants respectfully submit that Claim 1 is condition for allowance.

As Claims 2 and 4-7 depend from Claim 1, Claims 2 and 4-7 are also in condition for allowance. Newly amended Claim 8 recites "preventing the acceptance to the response after the session." Thus, Claim 8 is also allowable over the cited reference of Mashinsky for the same reasons and is therefore also in condition for allowance.

Claims 5 and 6 were rejected by the Examiner under 35 U.S.C. 103(a) as being unpatentable over Mashinsky in view of U.S. Patent No. 6,598,026 ("Ojha"). Claim 6 recites "denying access by a service provider, during the session, to at least one response of the stored set of responses to requests for telecommunication services, wherein the response to which access is denied is the same as the response reflecting at least one telecommunication service offering capable of satisfying the requested telecommunication service." The Examiner asserts that Applicants invention "defines a session as a point in time for considering an offer" on page 3

of the original filed application. Applicants could not find such a definition. The only reference to session found on page 3 of the original filed application is a statement that the “system establishes a session for considering the purchase of telecommunication services” Applicants read such statement as stating a purpose for a session, the purpose of “considering the purchase of telecommunication service.” There is certainly no definition of session as a “point in time” on page 3.

The Examiner further asserts that Ojha discloses “a system and method comprising denying access by the service providers to the stored set of responses to purchase request for telecommunication service during the session.” However, the Examiner cites no portion of Ojha supporting such an assertion. Applicants have been unable to find such teachings in Ojha. In fact, as Applicants have previously noted in their response of September 7, 2004:

However, rules can still be changed in Ojha by a seller and there is no teaching in Ojha of limiting such changes or the time of such changes. The current Office Action seems to be suggesting that rules are locked in after being set for the first time. There is no such teaching in Ojha, which effectively teaches the opposite. Moreover, nothing in Ojha suggests limiting or denying changes on any level. Instead, Ojha actually teaches away from denial of access to a seller. In particular, in the same Figure mentioned generally by the current Office Action without citing specific references, Ojha teaches email response mechanisms to notify sellers of buyers “as soon as they are available at the transaction site.” See Column 15, lines 46-50. Ojha teaches that such notification removes the need for constant monitoring and immediately thereafter that a seller can update rules using HTML interfaces. See Column 15, lines 50-64. Indeed, Ojha even suggests that once a seller is notified of a particular buyer, the seller can use these same interfaces to specify new rules to give a specific response to the specific buyer. See Column 15, line 64 through Column 16, line 4. Thus, Ojha teaches away from the limitations of Claims 5 and 6 in an even stronger manner than the initial reference of Mashinsky.

The Examiner’s response to Applicants characterization of Ojha appears to be threefold. First, the Examiner asserts that a seller specifies business rules that are then implemented

automatically by the system during a session. While Applicants do not dispute this characterization of Ojha, Applicants respectfully submit that having automatic rules is not relevant in any manner to a teaching of “a system and method comprising denying access by the service providers to the stored set of responses to purchase request for telecommunication service during the session.” If Ojha had a rule that prevented rules from changing during a session, it may be relevant, but Ojha does not provide any such teaching. In fact, Ojha teaches that a rule may be used to notify a seller of a current session and goes on to teach that changes can be made to rules as a result.

Second, the Examiner asserts that the session in Ojha “is practically instantaneous.” Applicants have not been able to find any portion of Ojha that teaches such an instantaneous session, and the Examiner has not provided a reference within Ojha. However, even if such a characterization of Ojha were true, such a characterization is not relevant to “denying access by the service providers.” Asserting that a reference teaches that such a session is very short does not mean the reference teaches denying access. The length of a session is completely unrelated to whether or not a system denies access to a seller during a session.

Third, the Examiner asserts that “the seller would no longer have access or the opportunity to change those rules during the particular negotiation session, wherein as practiced the session is practically instantaneous.” To the extent this is different from the Examiner’s instantaneous assertion, the Examiner has not provided any reference within Ojha teaching that “the seller would no longer have access...to change those rules.” Again, Applicants could find no such reference.

Additionally, as previously noted by Applicants in the response of September 7, 2004:

The Examiner initially rejected Claims 5-6 under 35 U.S.C. 102(e) over Mashinsky. However, Applicants successfully traversed such initial rejection by pointing out that Mashinsky actually teaches away from the recited elements of Claims 5 and 6 at Column 23, lines 1-6. The current Office Action in response to such traversal admits that Mashinsky does not disclose the recited elements of Claims 5 and 6 on page 4 but then asserts that Mashinsky should still be used in combination with Ojha to suggest the limitations of Claims 5 and 6. However, as the Examiner apparently agrees that Mashinsky teaches away from certain limitations of Claims 5 and 6, it would be improper to combine it with another reference the current Office Action asserts teaches the missing limitations from Mashinsky. Indeed, the current Office Action's only basis for suggesting the combination of the two references is that they both concern electronic commerce. The current Office Action does not even address the fact that one of the references teaches away from the very aspects of the other the current Office Action is seeking to combine. Clearly, one reference that teaches away from another reference cannot be said to suggest the other reference.

The Examiner's only response to such teaching away of Mashinsky and the improper nature of the rejection of Claims 5 and 6 by a combination of Mashinsky and Ojha is that "the nature of the teaching is highly relevant and must be weighed in substance." However, the Examiner does not then evaluate the relevancy of or weigh the teachings or the teachings away of Mashinsky. In fact, the Examiner has never commented on the teachings away of Mashinsky throughout the prosecution of this case. In evaluating the relevancy of and weighing the teachings of Mashinsky, it seems to Applicants both highly relevant and of great weight that Mashinsky affirmatively teaches away from the very element that the secondary reference of Ojha is introduced to show. Thus, contrary to suggesting the desirability of such a combination, Mashinsky teaches that it should not be combined with a system such as Ojha. The Examiner has never disputed this characterization of Mashinsky. As noted above, the fact that both references concern electronic commerce as a grounds for combination and the fact that a combination of selected elements of each system would, using hindsight, seem desirable is not adequate

grounds for combination even without the teachings away of Mashinsky. Particularly when taken with such teachings away, Applicants respectfully submit that the combination of references for the rejection of Claims 5 and 6 is improper.

Thus, Applicants respectfully submit that Claims 5 and 6 are in condition for allowance. Claim 9 similarly recites “preventing the service provider from modifying the set of responses during the session.” Thus, for the same reasons, Applicants respectfully submit that Claim 9 is also in condition for allowance.

Thus, all grounds of rejection and/or objection are traversed or accommodated, and favorable reconsideration and allowance are respectfully requested. Should the Examiner have any further questions or comments facilitating allowance, the Examiner is invited to contact Applicant's representative indicated below to further prosecution of this application to allowance and issuance.

Respectfully submitted,

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